

Response filed September 10, 2004 to April 21, 2004 Office Action
Ser. No. 09/939,406
Atty. Docket No. 1662/49603

REMARKS

Prior to entry of the foregoing amendment, claims 1-4, 6-18, 49, 51, 53-55, 63 and 68-76 were pending. By the foregoing amendment, claims 1, 68, 70, 71, 72 and 76 have been amended and claims 51, 53, 54, 55, 63 and 74 have been canceled. Therefore, upon entry of the foregoing amendment, claims 1-4, 6-18, 49, 68-73, 75 and 76 will be pending. Of these, claims 1, 49 and 72 are independent claims. Entry of the foregoing amendments and reconsideration of the subject application are respectfully requested.

I. Rejection Under 35 U.S.C. § 112, 1st paragraph

Claims 1-3, 6-18, 53, 72 and 73 have been rejected under 35 U.S.C. §112, 1st paragraph, as allegedly not being supported by an enabling disclosure. This rejection is traversed insofar as the Examiner considers it applicable to any claim pending in the subject application upon entry of the foregoing amendment and consideration of the remarks below.

It is respectfully submitted that this rejection is obviated with respect to claim 53, which has been canceled by the foregoing amendment.

The Examiner alleges that the specification does not adequately enable one skilled in the art "how to use" compounds of claims 1 and 72 in which the scope of the R² substituent includes alkoxy, phenyl, phenyloxy and phenylalkoxy. In previous Office Actions, the Examiner has indicated that because the compounds are used to make mirtazapine and mirtazapine analogs as disclosed in U.S. 4,062,848, useful for treating depression, the scope enablement of the presently claimed R² substituent should not exceed the scope for the corresponding substituent in the compounds disclosed in the '848 patent. The Examiner has stated on the record that "[a]ll applicants have to do to overcome this rejection is to show other known and useful 'piperazinoazepines' they urge can be made via instant piperazines with R² scope as alkoxy, phenyl, phenyloxy and phenylalkoxy."

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For the reasons of record, Applicants respectfully submit that the present specification enables the full scope of the R^2 substituent defined as alkoxy, phenyl, phenyloxy and phenyalkoxy.

However, to properly respond to the Final Rejection and expedite allowance, Applicants have amended claims 1 and 72 to recite that the R^2 substituent is alkyl, to which the Examiner has previously indicated no objection.

Applicants reserve the right in a continuing application to prosecute claims having the R^2 substituent defined as alkoxy, phenyl, phenyloxy and phenyalkoxy and to present additional arguments and/or evidence establishing that the specification enables this scope.

Claims 51, 53, 54, 55, and 74 have been canceled to avoid redundancies associated with the amendments to claims 1 and 72. Claim 76 has been amended to delete " R^2 is alkyl" to avoid redundancy with claim 72, from which claim 76 depends.

II. Rejections Under 35 U.S.C. § 112, 2nd Paragraph

Claims 68-70 have been rejected under 35 U.S.C. § 112, 2nd paragraph, as allegedly being indefinite.

As suggested by the Examiner, claims 68, 70 and 71 have been amended to recite "a" compound of claim 49 rather than "the" compound of claim 49 because claim 49 includes more than a single compound within its scope. Withdrawal of this aspect of the section 112, 2nd paragraph rejection is respectfully requested in view of this amendment.

The Examiner has also requested that "piperazynyl" in claim 70 be changed to --piperaziny--. The spelling correction has been made. Accordingly, withdrawal of this aspect of the section 112, 2nd paragraph rejection is respectfully requested.

III. Rejections Under 35 U.S.C. § 101 Paragraph

The Examiner has rejected claim 63 under statutory double patenting grounds as being identical to claim 13 in commonly-owned U.S. Patent No. 6,339,156.

Claim 63 has been canceled, thereby obviating this rejection.

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CONCLUSION

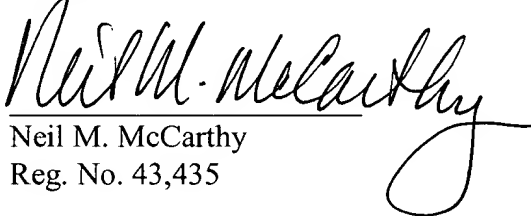
Entry of the foregoing amendments is respectfully requested. In view of the foregoing amendments and remarks, an early and favorable action on the merits is earnestly solicited. The Examiner is invited to contact the undersigned attorney if such communication is believed to be helpful in advancing the examination of the present application. The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. §1.16 or §1.17 to Deposit Account No. 11-0600.

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Respectfully submitted,

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